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From: Lourdes Perez Legal Assistant to Wing Yan Mok	No. of Pages Including Cover Sheet: 13
Message: Enclosed herewith: <ul style="list-style-type: none">• Transmittal Document; and• Reply Brief.	
Re: Application No. 09/895,095 Attorney Docket No: AUS920010447US1	
Date: Monday, April 25, 2005	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Banerjee et al.**Serial No.: **09/895,095**Filed: **June 29, 2001**For: **Digital Rights Management**§
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§Group Art Unit: **3621**Examiner: **Bayat, Bradley B.**Attorney Docket No.: **AUS920010447US1****35525**PATENT TRADEMARK OFFICE
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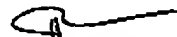
Sir:

ENCLOSED HEREWITH:

- Reply Brief (37 C.F.R. 41.41).

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

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Docket No. AUS920010447US1

PATENT

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In re application of: **Banerjee et al.**

Serial No. **09/895,095**

Filed: **June 29, 2001**

For: **Digital Rights Management**

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Group Art Unit: **3621**

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By:


Lourdes Perez

REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on March 8, 2005.

No fees are believed to be required to file a Reply Brief. Any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.

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ARGUMENT

I. 35 U.S.C. § 103(e), Alleged Obviousness, Claims 1-35

In the Examiner's Answer, the Examiner rejects Appellants' argument that Christiano does not disclose the feature of "associating a second field with the electronic property, wherein the second field includes a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners," as recited in independent claims 1, 17 and 33 of the present invention.

With respect to claims 1-35, the Examiner states:

At the outset, the examiner asserts that Appellant's second element/step represents nonfunctional descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed. MPEP 2106 IV B 1(b). In analyzing claim language for its limiting effect, the examiner has applied two basic steps: i) review the claim as a whole to see whether or not any descriptive material is being recited; ii) if descriptive material is found, determine how this descriptive material is being used in the claim as a whole, and ultimately conclude whether the data in question alters or reconfigures the system or method steps, or merely means something to the human mind. *Id.* Common limitations where nonfunctional data could be found often include those directed to sending, receiving, storing, and displaying data. *Id.* The second element/step of Appellant's claim recites historical ownership data of electronic property associated with a second field. This "data" qualifies as descriptive material since it is directed to the information content of what is collected. With regards to how this descriptive material is being used, Appellant's second field is not explicitly recited as being altered or impacted by any other field/element/step in the claim. Except for the meaning of the data to the human mind, the collection of ownership/rights transfer data would be the same with any other type of data, wherein the second field lacks any functional relationship to the first field as recited in the claim and the interrelationship of the elements in the claim as a whole. Thus, such nonfunctional descriptive material will not distinguish the claimed invention for the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Examiner's Answer dated March 8, 2005, pages 7-8.

Appellants respectfully disagree with the Examiner's assertion that the second element/step of the present invention represents nonfunctional descriptive material as set forth in MPEP section 2106 IV B 1(b), because the Examiner's rejection based on the MPEP section

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2106 IV B 1(b) constitutes a new ground of rejection under 35 U.S.C. § 101, which is prohibited in the Examiner's Answer according to MPEP section 1208.01. MPEP section 1208.01, which describes Prohibition Against Entry of New Ground of Rejection in Examiner's Answer, reads as follows:

37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection). (Emphasis added).

MPEP section 1208.01.

As stated in the above section, where the statutory basis for the rejection remains the same, the rejection does not necessarily constitute a new ground of rejection. However, in the Examiner's Answer, the Examiner relied his rejection of independent claim 1 on MPEP section 2106 IV B, which states that "descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101." Thus, the assertions made by the Examiner clearly changes that statutory basis for the rejection, from statutory subject matter under 35 U.S.C 103(a) to the alleged nonfunctional descriptive material under 35 U.S.C 101. Therefore, the rejection made by the Examiner in the Examiner's Answer constitutes a new ground of rejection, which is prohibited in the Examiner's Answer according to MPEP section 1208.01.

Accordingly, Appellants respectfully request the withdrawal of the rejection made by the Examiner with regard to the second element/step of independent claim 1 of the presently claimed

invention based on the fact that the rejection made by the Examiner in the Examiner's Answer constitutes a new ground of rejection that is prohibited under MPEP section 1208.01.

In addition, even if the rejection made by the Examiner in the Examiner's Answer were proper, the second element/step of independent claim 1 still does not fall within the nonfunctional descriptive material category as alleged by the Examiner. In addition to the section cited by the Examiner, MPEP section 2106 IV B 1(b) also states:

Office personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. (Emphasis added).

MPEP section 2106 IV B 1(b).

Independent claim 1 of the presently claimed invention recites:

1. A method of augmenting digital rights management, the method comprising:
 - associating a first field with an electronic property, wherein the first field identifies a current owner of the electronic property; and
 - associating a second field with the electronic property, wherein the second field includes a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners; and
 - wherein access control software allows access to the electronic property only upon verification that a user satisfies specified requirements for access, and wherein the specified requirements include the user being listed as the current owner in the first field. (Emphasis added)

As recited in claim 1 above, a first and a second field are associated with an electronic property. The first field identifies a current owner of the electronic property. The second field includes a list of owners having an order according to a historical order of transfer of rights to the electronic property. The access control software allows access to the electronic property based on verification of a user satisfying a specified requirement that the user being the current owner in the first field. Thus, the second field, which is associated with the electronic property, is claimed in combination with the first field, which is also associated with the electronic property, to provide the necessary functional interrelationship of verifying satisfaction of specified requirements.

According to page 12, lines 4-20 of the current specification, the first field refers to the party that currently owns the rights to the digital property in question and can be used in rights enforcement and to legally transfer the property among parties. The second field is a list of prior owners and can provide valuable information to the manufacturer and can be useful in case of disputes. Access control software can check these variables to ensure that digital rights are being respected and can send back information to the manufacturer in case of abuse or violation. Thus, the first field and the second field in combination are associated with the electronic property to provide the necessary functional interrelationship in order to enforce digital rights and send back information to the manufacturer. Appellants respectfully submit that the second element/step of independent claim 1 is not nonfunctional descriptive material according to MPEP section 2106 IV B 1(b), because the claimed second field in combination with the claimed first field provides the necessary functional interrelationships to satisfy the requirement of 35 U.S.C 101. Therefore, Appellants respectfully request the withdrawal of the rejection made by the Examiner with regard to the second element/step of independent claim 1.

Furthermore, the Examiner alleges in the Examiner's Answer that Christiano teaches the feature of associating a second field with the electronic property, wherein the second field includes a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners, as recited in independent claim 1 of the presently claimed invention. The Examiner states in the Examiner's Answer:

Christiano principally teaches the use of a license management system and method wherein the license server creates a license database after receiving license data and/or package certificates, including a computer's node, address, serial number, licensee user name, or other identifier information to examine "license records to determine whether a requesting computer system should be allowed access to the digital property (column 6, line 64 - column 7, line 46; column 8, lines 30-67; column 9, lines 9-64)." Therefore, since Christiano's license server stores identifiers with respect to digital property rights for purposes of access or license violation notification, such transfer of rights or "list of owners" as defined by Appellant is recorded regardless of whether the license is active (current owner) and allowed access or inactive (previous owner) and refused the right to use of the digital property. (Emphasis added).

Examiner's Answer dated March 8, 2005, pages 8-9.

Appellants respectfully disagree with the Examiner's allegation that because of the identifiers stored in the license server, a list of owners having an order according to a historical

order of transfer of rights to an electronic property between a plurality of previous owners is recorded by Christiano's license management system regardless of whether the license is active or inactive. At column 8, lines 46-56, Christiano teaches that the license server examines package description and determines how many license records are written into the internal license database. The license server examines the license records to determine whether a computer system should receive a license for a designated software product. Christiano teaches in **Figure 2b** a package certificate that includes a package license description from which the license record is derived. **Figure 2b** of Christiano is illustrated below:

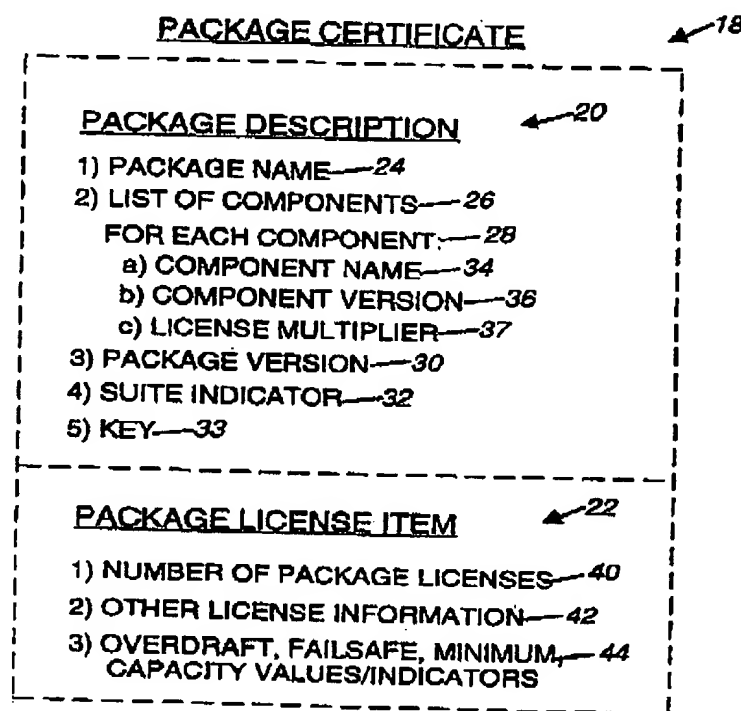


Figure 2b

As shown in **Figure 2b** above and at column 8, line 57 to column 9, line 64, Christiano teaches package description 20 that includes package name 24, list of components, 26, component name for each component 34, component version for each component 36, license multiplier 37 for each component, package version 30, suite indicator 32, and key 33. Package name 24 describes the package name, which is identifier of the package. This name is searched by license server to

match a package license to a request for a package license. List of components 26 includes all component software products that are included within package product name 24. Each component in list of components 26 has a name or identifier field 34 identifying the name that can be matched with a request, version field 30 storing the version of the component program, and license multiplier 37 used to determine the number of authorized component licenses available. Package version 30 stores the version of the package and suite indicator 32 stores a flag indicating whether the current package is a suite. However, none of the identifiers in package description 20 records a list of owners having an order according to a historical order of transfer of rights to an electronic property between a plurality of previous owners, as alleged by the Examiner. The identifiers stored by Christiano merely help the license server in identifying the correct component and package in order to determine whether a computer system should receive a license. Nowhere in Figure 2b or any other section of the reference does Christiano teach or suggest that a list of owners having an order of a historical order of transfer of rights to an electronic property between a plurality of previous owners is recorded.

In addition, also shown in Figure 2b, package license item 22 includes the number of package license portion 40, which stores the number of available package licenses (or license units) for that package. Other information portion 42 stores other license information, such as date of expiration, a key for verification that license item has not been tempered with, etc. Option portions 44 stores optional license modifier, such as overdraft quantity, failsafe indicator, minimum quantity, and capacity indicator. None of these identifiers in package license item 22 indicate a list of owners having an order according to a historical order of transfer of rights to an electronic property between a plurality of previous owners. Therefore, the allegation made by the Examiner that Christiano records a historical order of transfer of rights to an electronic property between a plurality of previous owners regardless of whether the license is active is not supported in any of the identifiers as stated in the reference.

Furthermore, the Examiner alleges that the Appellants' argument of Christiano including only a list of current users rather than previous owners is tenuous, because in order for the license server to provide access to digital property, it must necessarily store a list of active (current owner) and inactive (previous owner) licenses to allow or refuse access, to allow renewal of transfer of rights upon expiration of a license term, and offer updated version of the digital property to

licensees. The Examiner also alleges that Christiano teaches these features at column 12, line 11 to column 13, line 23, wherein Christiano teaches licensee data that is compared against a permissions database to determine whether a licensee holds a current valid license or previously expired license. Appellants respectfully disagree.

It is not necessary to store a list of owners having an order according to a historical order of transfer of rights to an electronic property between a plurality of previous owners in order to allow or refuse access, to allow renewal of transfer of rights upon expiration of a license term, and to offer an updated version of the digital property to licensees. In particular, at column 18, line 62 to column 9, line 65, Christiano teaches a process for determining if a license record is available for the requested product that is used to allow or deny access, in which the number of duplicate units in the user list is subtracted from the number of license units requested. The user list is a list of requesters that have requested the license record in question and are currently using a license, and includes the number of units that each such requester currently has checked out. Duplicate units are units that are currently checked out by the same user for the same license. Thus, in allowing or denying access, Christiano only teaches the use of a user list that includes a number of current users who had checked out the license. Christiano does not teach or suggest the use of a list of previous users having an order according to a historical order of transfer of rights between a plurality of previous users.

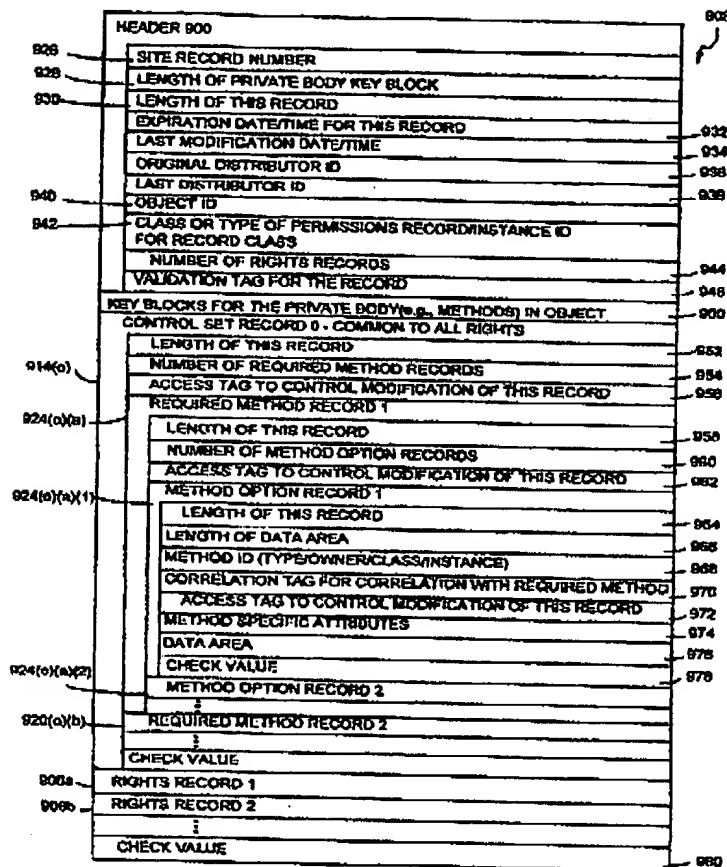
In addition, even if Christiano teaches a list of previous users, it is still not necessary that the list of previous users having an order according to a historical order of transfers of rights to an electronic property between a plurality of previous users. As a person of ordinary skill in the art would recognize, the list of users may be stored in any order, not necessarily in the order the rights of an electronic property is transferred. Absent some disclosure by the Appellants, a person of ordinary skill in the art would not have stored a list of users having an order according to a historical order of transfer of rights to an electronic property between a plurality of previous users, since there is no teaching or suggestion made by either Ginter or Christiano to store the list of owners according to a historical order of transfer of rights. Therefore, the allegation made by the Examiner that Christiano must necessarily store a list of owners having an order according to a historical order of transfer of rights to an electronic property between a plurality of previous users is also not supported in the reference.

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Moreover, the Examiners alleges that Ginter teaches the features of associating a second field with the electronic property, wherein the second field includes a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners, as recited in independent claim 1 of the presently claimed invention, because Ginter discloses a "chain of handling and control VDE," wherein it administers protection of digital property rights with regard to authors of electronic content, commercial rights of distributors of content and any other rights with regard to access, distribution and enforcement of digital property (column 5, lines 28-43; column 6, lines 12-26). The Examiner further alleges that in Figures 80-83, Ginter teaches a plurality of parties typically involved in transfer of digital property rights including creator, distributor, and users, wherein usage, access, or transfer rights with respect to each party are recorded and utilized in enforcement of such rights. Ginter's VDE in fact administers transactions that specify protection of rights by recording, auditing, controlling and enforcing rights of users as well as authors (manufacturers), and distributors of electronic content (column 5, lines 28-43). Appellants respectfully disagree.

In the Final Office Action dated July 15, 2004, the Examiner admits that Ginter does not explicitly teach the feature of associating a second field with the electronic property, wherein the second field includes a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners and alleges that Christiano teaches these features. However, in the Examiner's Answer, the Examiner rejects the same features as being unpatentable over Ginter, because Ginter teaches a chain of handling and control VDE. At column 6, lines 12-26, Ginter merely teaches the chain of handling and control a VDE is passing the electronic rights information through a chain of distributors and a chain of users. In Figure 26a, Ginter teaches a permission record header that specifies the electronic rights information associated with an object, such as who can open the container, who can use the object's content, who can distribute the object. Figure 26a of Ginter is illustrated below:

FIG. 26A



As shown above in Figure 26a, permission record header 900 only includes an original distributor ID field 936, which specifies who originally distributed the object, and last distributor ID field 938 that specifies who the last distribute of the object was. These two ID field fails to provide a list of owners having an order according to a historical order of transfer of rights, since only the original and the last distributor are recorded. While Ginter teaches that electronic rights information may be passed through a chain of distributors and users, Ginter fails to teach or suggest storing the rights information of the distributors and users in an order having a historical order of transfer of rights between a plurality of previous owners. As to Figures 80-83, Ginter merely teaches how control information may be distributed from one distributor to another distributor. Ginter does not teach or suggest that the control information includes a list of owners having an order according to a historical order of transfer of rights between a plurality of previous owners. Specifically, at column 330, lines 12-24, Ginter teaches that the control information includes: (a)


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transaction, session, time based, or other threshold placed on usage; (b) privacy requirements of user A with respect to recording and/or transmission of certain usage; and (c) backup requirements that user A places on herself to ensure a preservation of value. Thus, nowhere in the control information is a list of owners having an order according to a historical order of transfer of rights of an electronic property between a plurality of previous owners recorded. Therefore, the allegation made by the Examiner that Ginter teaches the features of independent claim 1 due to Ginter's teaching of a chain of handling and control VDE is also not supported by the reference.

In view of the above, neither Ginter nor Christiano teaches or suggests the features of independent claim 1, which is representative of claims 17 and 33 with regard to similarly recited subject matter. At least by virtue of their dependency on claims 1, 17, and 33, neither Ginter nor Christiano teaches or suggests the features of dependent claims 2-16, 18-32, and 34-35. Accordingly, Appellants respectfully request withdrawal of the rejection of claims 1-35 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the comments above, Appellants respectfully submit that the rejections of claim 1-35 are overcome. Accordingly, it is respectfully urged that the rejection of claims 1-35 not be sustained.


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